

II. Remarks

The Official Action of April 17, 2009 has been thoroughly studied. Accordingly, the following remarks are believed to be sufficient to place the application into condition for allowance.

By the present amendment the claims have been changed to address and overcome the outstanding rejections under 35 U.S.C. §112, first and second paragraphs and the informalities noted by the Examiner on page 2 of the Office Action.

Otherwise the claims have been changed to more clearly describe applicant's invention in accordance with the requirements of 35 U.S.C. §112.

It is submitted that the changes to the claims presented herein are properly enterable after Final inasmuch as the changes presented herein address and overcome the outstanding rejections under 35 U.S.C. §112, first and second paragraphs and the informalities noted by the Examiner on page 2 of the Office Action without changing the overall scope of the claims and without adding any new matter to the claims.

Further, the changes to the claims are believed to reduce matters under 35 U.S.C. §112 should the application proceed to appeal.

Otherwise, as noted below, applicant's invention is believed to define over the prior art of record, so that the application should properly be allowed.

On page 2 of the Office Action the Examiner has rejected claims 1-8 under 35 U.S.C. §112, first paragraph.

Under this rejection the Examiner has taken the position that the recitations: "generate a material-permeable vapor which is communicated to the skin of the body"

and “the first and second attachment means is hook and loop fabric” were not supported by applicant's original specification.

By the present amendment the phrase “generate a material-permeable vapor which is communicated to the skin of the body” has been avoided. In this regard, the claims have been drafted to recite that that herb(s) is/are heated and generate a vapor and the herbal pack retainer is made of a material that is permeable to the generated vapor.

Claim 4 has been changed to recite that the first and second attachment means comprise cooperatively engagable hook and loop fasteners.

It is noted that applicant's original specification discloses VELCRO fasteners which are well-known hook and loop fasteners. It is believe that those skilled in the art would readily understand that VELCRO is synonymous with cooperatively engagable hook and loop fasteners.

It is the undersigned's understanding that the use of trademarks in claims is generally discouraged and applicants are instead encourage to use general or generic descriptions rather than trademarks. (See page 3 of the May 7, 2008 Office Action)

Accordingly the recitation of cooperatively engagable hook and loop fasteners in claim 4 is believed to be supported by applicant's original specification, understandable by those skilled in the art and otherwise proper.

Claims 1-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,657,531 to Church in view of U.S. Patent Application Publication No. 2003/0069618 to Smith, III et al. and further in view of U.S. Patent No. 4,657,531 to Choi.

For the reasons set forth below, it is submitted that each of the pending claims are allowable over the prior art of record and therefore, the outstanding rejection of the claims should properly be withdrawn.

Favorable reconsideration by the Examiner is earnestly solicited.

The Examiner has relied upon Church as teaching:

...a heating wrap for placement against an injured/painful area of a person's body (thus applied directly on to the skin of the body) and an analgesic cream being placed between the heating wrap and the injured/painful area. Church et al. further teach that the preferred list of ingredients for analgesic cream comprising aloe vera gel, garden balsam leaf extracts, coconut waxes, jasmine essence, willow extract, echinacea, horsechestnut extract etc (col 3, lines 60-68; col 4, lines 1-10) (thus a herbal applicator). The added heat from the heating wrap enhances the permeability of the skin and tendency of the cream to permeate into the skin (thus emit heat to reach a determined vaporizing temperature). The heat wrap may be a pad that includes a flexible sleeve (flexible main housing) for receiving and surrounding the pad, plus a set of straps for holding the pad or pad/sleeve combination on the body area that is to be treated (thus easily adapts to the contours of the body) (thus affixed with an attachment means and a corresponding attachment means is affixed on to the herbal pad retainer, the said attachment means is to facilitate easy removal and attaching of the herbal pad). The preferred heating wrap includes a thin sheet (top member) that will absorb water, which sheet (thus a fabric) may be dampened with water (thus prevent the heat generated from the heater pad from being dispersed to the outside) and inserted between the heating pad (bottom member) (thus made up of two sections, and allow easy removal of the herbal pack for replenishment) (thus contain the heat generated by the heater pad within to heat the herbs effectively) and surrounding flexible sleeve (heater pad retainer), for providing moist heat treatment (see Abstract). Church et al also teach that the preferred heating means is an electrical heating pad that is thermostatically-controlled (thus adjustable temperature controlled, for regulating the required temperature of the heater pad in order for it to vaporize the herbs contained in the herbal pack) (thus maintain the vaporizing temperature at a temperature level below combustion but sufficient be sufficient to cause the herbs contained in the herbal pack to emit said vapors of herbal essence) (col 1, lines 50-55). At last, Church et al teach that the addition of heat causes a deep-heating of the body tissue, without over-heating the skin, which increases the skin's permeability of the cream, and consequently increased deep-penetration of the herbal (thus it absorbs part of the heat and helps to reduce the vaporizing temperature), analgesic, antiinflammatory, and other ingredients of the cream (col 3, lines 7-15) (thus when the herbs inside the

herbal pack are heated, until the vaporize, the herbal pack retainer then will allow the vaporized herbal essence to permeate through it an onto the skin and at the same time absorb part of the heat that helps to reduce the vaporizing temperature to the curie temperature). Church et al teach placing the heating wrap over the affected body area and secure firmly yet comfortably with the elastic straps by wrapping the strap ends around the body part to be treated and connecting the hook and loop patches together (claim 5).

The Examiner concedes that Church et al. does not:

...teach the herbs generate a material-permeable vapor which is communicated to the skin, emit vapors of herbal essence, a flexible herbal pack retainer configured to retain said herbal pack in said communication when in said engagement and with said herbal pack retainer adapted to allow easy removal and replacement of the herbal pack, or using portable battery.

The Examiner has accordingly relied upon Choi as teaching:

...a therapeutic heating apparatus and more particularly to an electric heating cup which comprises a cotton pad containing extracts of mugwort herb (thus an herbal pack retainer with vapor permeable material) of other pharmaceutical ingredients in the pad. The therapeutic heating appliance is utilized by the patient for treating various portions of the body. Thus, the vapor produced from the medical ingredients of the pad (thus a permeable material) penetrates the body of the patient due to heating energy and pressure (thus emit heat to reach a determined vaporizing temperature) (col 1, line 5-16). Choi further teaches that a therapeutic heating apparatus comprising a base member having a handle, an electric heater, a detachable or attachable heat conducting plate, a dry pad containing mugwort herb tonics or active ingredients (thus configured to retain said herbal pack in said communication when in said engagement and with said herbal pack retainer adapted to allow easy removal and replacement of the herbal pack), and a cotton pad (thus a permeable material) to cover the pad for portions of the human body. Thus, the vapor produced from the medical ingredients of the pad by heat penetrate into the body of patient with heating energy and pressure for treating and healing up the human body (thus generate a material-permeable vapor which is communicated to the skin, thus emit vapors of herbal essence, thus it absorbs part of the heat and helps to reduce the vaporizing temperature) (col 1, lines 45-55). Choi also teaches the apparatus has a temperature control nub (thus maintain the vaporizing temperature at a temperature level below combustion but sufficient to cause the herbs contained in the herbal pack to emit said vapors of herbal essence).

The Examiner has relied upon Smith, III et al. as teaching:

...a method comprising heating the selected area to a sustained skin temperature, using a device comprising a heat source capable of conductively heating the selected area. The method also comprises administering simultaneously a topical composition containing an active agent (see Abstract), such as flavonoid compounds obtained as extracts from natural sources (e.g. plants) [0067] (thus an herbal applicator). Smith, III et al also teach that the term "wearable device", which includes the term "sleeve:, means a substantially flexible section of material in the form of, for example, a wrap, patch, cuff or a bandage which may be placed on/confirm to which may be held adjacent, selected are of the body (thus a flexible main housing which can be easily attached on to the body). Such as a wrap, patch, cuff or bandage may be formed form a substrate, preferably a disposable substrate (thus allow easy removal of the herbal pack for replenishment). The sleeve may, in addition, be dimensioned and adapted to apply compression. The sleeve in the form of a wrap, patch, cuff or bandage may be held in place by the use of straps or fasteners. For example, one side of the sleeve may be connected to the other side of the sleeve, using buttons. Velcro or the like [0055]. Smith, III et al further teach that the device can be either actively AC or DC powered (electrical, battery, etc) [0092]. Smith, III et al teach that a heating pad is prepared. Coated thermal resistance wire is sewn to a semi-rigid nylon (thus made of two sections). Excess mesh is folded over the wire and both sides of the wire and mesh are wrapped with, and sewn to, a polyester nonwoven batting (heater pad retainer). The end of the resistance wire is connected through bimetal thermal safety switches to an A.C. power source at 120 volts. A controller integral to the power cord includes a phase fired switch to create a user-adjustable temperature control (thus affixed with a flexible heater pad that connects to an electrical power source to be regulated by an adjustable temperature controller)(thus when the herbs inside the herbal pack are heated, until they vaporize, the herbal pack retainer the will allow the vaporized herbal essence to permeate through it and onto the skin and at the same time absorb part of the heat and helps to reduce the vaporizing temperature to a curie temperature). The entire assembly is wrapped and sealed in waterproof vinyl. A covering of soft polyester is wrapped over the vinyl, and two Velcro straps are sewn to the covering [0100]. Smith, III et al further teach that four additional layers of the same substrate, which is thermally insulating, are placed contiguous to the first substrate on the side away from the wires, and sewn together, to provide insulation against heat loss from one side of the pad (thus prevent the heat generated from the heater pad from being dispersed to the outside) but no insulation on the skin contact side. This arrangement is particularly beneficial in enabling low power and in facilitating therefore, the use of batteries (portable battery) as a power source.

In combining the teachings of Church et al. Choi and Smith, III et al. the Examiner takes the position that:

It would have been prima facie obvious...to us the herbs generate a material-permeable vapor which is communicated to the skin, emit vapors of herbal essence, a flexible herbal pack retainer configured to retain herbal pack to allow easy removal and replacement of the herbal pack from Choi since the therapeutic heating apparatus of Choi yielded beneficial results in treating various portions of the human body without producing herb ask or smoking gas (col 1, lines 29-37), one of ordinary skill in the art would have been motivated to make the modifications to combine the inventions together.

and

It would have been prima facie obvious...to use the portable battery from Smith, III et al since Smith, III et al teach the heating device with portable battery yielded beneficial results in cosmetic treatment of skin conditions such as regional fat deposits.

Whether the present amendments the claims are entered or not, applicant's independent claims 1 and 8 require a flexible heater pad. The flexible heater pad was/is required to be:

- 1) Connected to an electrical power source; and
- 2) In contact with the herbal pack.

The herbal pack is retained in contact with the flexible heater pad by the herbal pack retainer and the herbal pack contains an herb (or herbs).

These elements - the flexible heater pad, herbal pack and herbal pack retainer - and their configuration, arrangement and functional cooperation are required to be found in the prior art to properly reject applicant's claimed invention.

In relying upon Church et al. the Examiner has stated:

...The heat wrap may be a pad that includes a flexible sleeve (flexible main housing) for receiving and surrounding the pad, plus a set of straps for holding the pad or pad/sleeve combination on the body area that is to

be treated (thus easily adapts to the contours of the body) (thus affixed with an attachment means and a corresponding attachment means is affixed on to the herbal pad retainer, the said attachment means is to facilitate easy removal and attaching of the herbal pad). The preferred heating wrap includes a thin sheet (top member) that will absorb water, which sheet (thus a fabric) may be dampened with water (thus prevent the heat generated from the heater pad from being dispersed to the outside) and inserted between the heating pad (bottom member) (thus made up of two sections, and allow easy removal of the herbal pack for replenishment) (thus contain the heat generated by the heater pad within to heat the herbs effectively) and surrounding flexible sleeve (heater pad retainer), for providing moist heat treatment (see Abstract). Church et al also teach that the preferred heating means is an electrical heating pad that is thermostatically-controlled (thus adjustable temperature controlled, for regulating the required temperature of the heater pad in order for it to vaporize the herbs contained in the herbal pack) (thus maintain the vaporizing temperature at a temperature level below combustion but sufficient be sufficient to cause the herbs contained in the herbal pack to emit said vapors of herbal essence) (col 1, lines 50-55). At last, Church et al teach that the addition of heat causes a deep-heating of the body tissue, without over-heating the skin, which increases the skin's permeability of the cream, and consequently increased deep-penetration of the herbal (thus it absorbs part of the heat and helps to reduce the vaporizing temperature), analgesic, anti-inflammatory, and other ingredients of the cream (col 3, lines 7-15) (thus when the herbs inside the herbal pack are heated...

It is not clear how the Examiner moves from Church et al. teaching that the heat wrap may be a pad to Church teachings an "herbal pad [pack]" and an "herbal pack retainer."

Church et al. teaching the application of a cream onto the skin of a person and then "gently rub[bing] the cream into the skin" (Col. 4, lines 56-57). Next the heating wrap is placed over the affected area and heating the heating wrap.

Church et al. does not teach providing any herbs in a structure that corresponds to applicant's claimed "herbal pack" which is held in contact with a heater pad by a flexible herbal pack retainer, and which "herbal pack" contains an herb (or herbs).

Thus Church et al. does not teach all the structural elements of applicant's claimed invention (such as the herbal pack and flexible herbal pack retainer) together with the structural relationship of the elements (such as the flexible herbal pack retainer retaining the herbal pack (which contains an herb or herbs) in contact with the flexible heater pad) – all within the flexible housing.

Choi does not teach the structural features which Church et al. fails to teach.

Choi teaches a cotton pad 22 that is in contact with a heat conductive plate 12.

This arrangement precludes Choi from teaching an herbal pack held in contact with a heater pad.

In Choi the heat conductive plate 12 does not read on applicant's claimed flexible heater pad. In this regard note applicant's claimed flexible heater pad is required to be "connected to an electrical power supply."

In Choi it is only the electrical heater 7 that is "connected to an electrical power supply."

Thus, the heat conducting plate 12 of Choi does not read on applicant's claimed flexible heating pad.

Further the electrical heater 7 of Choi is not in contact with the cotton pad 22 (because of the intervening heat conductivity pad 12) and thus does not read on applicant's flexible heating pad which is on contact with applicant's herbal pack.

Even further the cotton cover 24 of Choi does not retain the cotton pad 22 in contact with the electrical heater 7 (because of the intervening heat conductivity pad 12) and thus does not read on applicant's claimed flexible herbal pack retainer.

Therefore, Choi does not teach all the structural elements of applicant's claimed invention (such as the herbal pack, flexible herbal pack retainer and flexible heating

pad) together with the structural relationship of the elements (such as the flexible herbal pack retainer retaining the herbal pad (which contains an herb or herbs) in contact with the flexible heater pad).

It accordingly follows that Choi does not teach the structural features which Church et al. fails to teach.

Therefore the combination of Church et al. and Choi does not render applicant's claimed invention obvious.

In addition to the structural relationship of the elements of the present invention and those of Church and Choi, it is noted that applicant's invention involves the use of an herb or herbs, rather than extracts of herbs.

As noted above the Examiner has relied upon Choi as teaching "a cotton pad containing extracts of mugwort herb"

The present invention utilizes herbs rather than the extracts of herbs. That is, the present invention utilizes herbs in a natural or raw state.

As specifically stated in the first paragraph under applicant's Summary of the Invention section:

It is the object of the present invention to provide for such a simple, versatile, easily adaptable and economical device that can cater for the use of other forms of herbs, especially in their natural, state instead of extracts, to incorporate the use of heat on the said herbs, so as to vaporize the said herbs, until they can be easily permeated into the skin of the person, when the said applicator is applied and attached to the skin of the particular person.

Herbs in their natural state are entirely different from herbs that have been pressed into extracts, as one skilled in the art would clearly understand.

Thus, it is submitted that the prior art of Church and Choi fail to teach or suggest the use is applicant's herbal pack which contains an herb.

The Examiner has relied upon Smith, III et al. as teaching a battery.

The Examiner's reliance upon Smith, III et al. does not address or overcome the distinctions between the combination of Church et al. and Choi and applicant's claimed invention.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicants' claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejection of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

Conclusion

It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved; the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 23-1925 and please credit any excess fees to such deposit account.

Respectfully submitted,

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